

## REMARKS

### Claim Status

Claims 11-23 and 43 are pending in the present application, and all claims are thought to be allowable over the cited art.

### Rejections Under 35 USC §103(a)

#### Claims 11, 22, and 43

Claims 11, 22, and 43 are understood to be patentable under 35 USC §103(a) over Shyu (US Patent 6,175,951) in view of Henson (US Patent 6,167,383). The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by the references and does not provide a proper motivation for modifying the teachings of Shyu with teachings of Henson.

In regards to claim 11, the Shyu-Henson combination does not suggest the claimed limitations of "receiving a plurality of configurations from a plurality of customers by a vendor of the programmable integrated circuits." Shyu teaches that a vendor fabricates integrated circuits with different customer-specific codes, and each different customer of the vendor configures the integrated circuit with a customer-specific configuration (Col. 1, lines 16-18; Col. 1 line 64 through Col. 2 line 1; Col. 4, lines 10-18). There is no apparent suggestion by Shyu that the vendor ever receives the configurations from the customers. Nor does Henson appear to suggest the configuration of any integrated circuit; Henson instead teaches customer selection of optional components of a computer system (FIGs. 3A and 3B).

In addition, the Shyu-Henson combination does not suggest the limitations from claim 11 of "loading by the vendor, a decryption program into the specified volumes of ICs, wherein the decryption program is provided by the first customer." The Shyu-Henson combination does not appear to provide any teachings for a decryption program. Instead, Shyu teaches a matching circuit that enables application circuits when a proprietary code sequence matches the preset code sequence (Abstract; Col. 6, lines 6-11). Those skilled in the art will recognize that a proprietary code sequence is not suggestive of a decryption program. If the rejection is maintained, an

explanation is requested as to how decryption is thought to correspond to a proprietary code. Furthermore, there is no apparent customer-provided decryption program suggested by Shyu. Thus, these limitations are not shown by the Shyu-Henson combination.

Henson does not suggest the claimed receiving and storing of a plurality of configurations. In the cited teachings of Henson there are no apparent unprogrammed ICs into which the claimed configurations could be loaded. Henson may pull a processor from inventory for building a computer system, but there is no apparent suggestion that customer-provided configuration is loaded into that processor. Henson's customization information is cited as corresponding to the claimed configuration. However, the designation of quantity of memory, size of hard drive, monitor type and size, video card, speakers, bundled software etc. is not loaded into any IC for shipment to the customer. Furthermore, Henson would have no apparent need for the vendor to encrypt a configuration selected by a customer. Henson may load customer-selected software onto the customer-selected hard drive, but those skilled in the art will recognize that the Henson's customers do not provide the software, and the software is not loaded into the processor IC by the vendor.

Furthermore, the Office Action does not provide a proper motivation for combining the teachings of Shyu and Henson. Shyu teaches an integrated circuit fabricated by a vendor with bonding pads wired according to a uniquely assigned code for each customer of the vendor (Col. 1, lines 16-18; Col. 1 line 64 through Col. 2 line 1; Col. 4, lines 10-18). Shyu's system is directed to protecting against the theft and reuse of programmed information for use on the same type of integrated circuit (Col. 1, lines 40-60). Thus, Shyu's system is predicated on the same type of device being shipped to different customers. Henson teaches customer selection of optional components of a computer system being purchased (FIGs. 3A and 3B). Thus, Henson is directed to different systems sent from a vendor to different customers. For at least these reasons, Henson's customization of systems would change a principle of operation of Shyu by way of the vendor shipping different systems to different

customers. Thus, the asserted motivation to modify Shyu with Henson's teachings is improper.

Claim 22 depends from claim 11 and includes additional limitations that further define the invention. Thus, the limitations of claim 22 are not shown to be suggested by the Shyu-Henson combination for at least the reasons above.

Claim 43 depends from claim 11 and includes additional limitations further defining a usage of the claimed decryption program. As discussed above, the Shyu-Henson combination does not appear to offer any teachings on decryption. Thus, the limitations of claim 43 are not shown to be suggested by the Shyu-Henson combination for at least the reasons above.

The rejection of claims 11, 22 and 43 should be withdrawn because a *prima facie* case of obviousness has not been established.

#### Claims 12-18

Claims 12-18 are understood to be patentable under 35 USC §103(a) over the Shyu-Henson combination in view of "Clinton" (US Patent 5,949,719 to Clinton et al.). The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by the Shyu-Henson-Clinton combination. Claims 12-18 depend from claim 11 and the limitations are not shown to be suggested for at least the reasons set forth above. The rejection of claims 12-18 should be withdrawn because a *prima facie* case of obviousness has not been established.

#### Claim 19

Claim 19 is understood to be patentable under 35 USC §103(a) over the Shyu-Henson combination as applied to claim 11 above, and further in view of "Giddings" (U.S. Patent No. 5,596,282 to Giddings et al). The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by the combination. Claim 19 depends from claim 11, and the limitations are not shown to be suggested for at least the reasons set forth above. The rejection of claim 19

should be withdrawn because a *prima facie* case of obviousness has not been established.

Claim 20

Claim 20 is understood to be patentable under 35 USC §103(a) over the Shyu-Henson combination in view of "Park" (US Patent 6,225,818 to Park et al.). The rejection is respectfully traversed because the Office Action does not show that all the limitations are suggested by the Shyu-Henson-Park combination. Claim 20 depends from claim 11, and the limitations are not shown to be suggested for at least the reasons set forth above. Therefore, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

Claim 21

Claim 21, which depends from claim 11, is not specifically addressed in the Office Action, and the cited prior art does not appear to suggest the limitations of the claim. Therefore, claim 21 is understood to be patentable, and the rejection should be withdrawn. If the rejection is maintained, Applicant respectfully requests citation to applicable prior art.

Claim 23

Claim 23 is understood to be patentable under 35 USC §103(a) over the Shyu-Henson combination in view of "Asar" (US Patent 6,434,264 to Asar). Claim 23 depends from claim 20, which depends from claim 11, and the limitations are not shown to be suggested for at least the reasons set forth above. Therefore, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

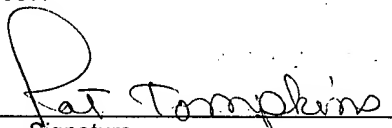
Respectfully submitted,



Lois D. Cartier  
Agent for Applicant  
Reg. No. 40,941

*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 24, 2007.*

Pat Tompkins  
Name

  
Signature